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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Fernando DONATE *et al.*

Serial. No. 10/661,784

Filed: September 15, 2003

For: HUMAN KININOGEN D3 DOMAIN POLYPEPTIDE AS
AN ANTI-ANGIOGENIC AND ANTI-TUMOR AGENT

Art Unit: 1642

Examiner: Anand U. Desai

Atty. Docket No. 38342-193024

Customer No.¹**30827****RESPONSE TO RESTRICTION REQUIREMENT**Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This paper responds to the Restriction/Election Requirement mailed 10 August 2004, the time for responding to which is extended one month to include 16 September 2004, with the accompanying Petition for Extension of Time.

The Office identified 8 allegedly independent inventions, which will not be reiterated here, and required election of one of these. Applicant elects, with traverse, Group 1, which encompasses, according to the Action, Claims 1-13, drawn to an anti-angiogenic polypeptide, and an anti-angiogenic pharmaceutical composition, classified in class 514, subclass 12.1.

Applicants believe that it would be proper to rejoin, for initial examination, the nucleic acid, vector and transformed cell claims (Group IV, claims 18-29). Such rejoinder would be proper because the angiogenesis inhibiting effects resulting from contacting or administration of the nucleic acid/expression vector or transformed are mediated by the expressed, encoded polypeptides, not by the administered nucleic acid or transformed cell itself.. The nucleic acids are, in effect, a form of delivery for the polypeptides because their expression will ultimately result in the availability of the polypeptides; this may be considered functionally equivalent to a protective coating or packaging of

¹ Customer number and correspondence address have changed – see accompanying Change of Address form. The Office is requested to note and enter the change of corresponding attorney address and customer number.

the active ingredient. All these claims thus define a unified invention that underlies the polypeptides and nucleic acids/transformed cells.

Applicants understand that process claims 14-17 directed to embodiments other than polypeptides *per se* (i.e., methods using the polypeptides) would be properly rejoined to the claims of Group 1 upon identification of patentable subject matter (and appropriate amendment of these withdrawn claims in concert with any amendments to claims 1-13 to maintain the same scope). Applicants believe that method claims 30-33 (Group V) may be properly rejoinder under *Ochiai* and *Brouwer* to nucleic acid claims of Group IV, which should be rejoined at this time in accordance with Applicants' request above. the methods of using the polypeptides and the nucleic acid (or transformed cells).

CONCLUSIONS

Applicants have responded fully to the Restriction Requirement, have requested rejoinder of one group of claims to the elected group, and discussed subsequent rejoinder of process claims under *In re Ochiai* and *In re Brouwer*. It is believed that the case is now in condition for examination and allowance.

If these papers are not considered timely filed by the Patent and Trademark Office, then a petition is hereby made under 37 C.F.R. § 1.136, and any additional fees required under 37 C.F.R. § 1.136 for any necessary extension of time, or any other fees required to complete the filing of this response, may be charged to Deposit Account No. 50-0911. Please credit any overpayment to deposit Account No. 50-0911.

Respectfully submitted,

Dated: September 16, 2004

By 

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